

Appln. No. 10/723,222
Amendment dated June 16, 2008
Reply to Office Action mailed January 14, 2008

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 3, 6 through 13 and 16 through 31 remain in this application. Claims 4, 5, 14 and 15 have been cancelled. No claims have been withdrawn. Claims 32 through 33 have been added.

Parts 1 through 4 of the Office Action

Claims 12, 20 through 23, 25, 27 and 29 have been rejected under 35 U.S.C. §102(e) as being anticipated by Asmussen.

Claim 24 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Asmussen.

Claim 31 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Asmussen in view of Christopher.

Claim 26 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Asmussen in view of Brunelle.

Claim 12

Claim 12 requires, in part, "wherein a portion of the real time program is not buffered by the means for buffering to facilitate coincidence of the buffered program with the real-time program".

Looking first to some of the remarks made in the "Response to Applicant's Arguments After Final Rejection" in the Advisory Action, it is stated on page 2 that "[t]his clearly means a portion of the real time [program] is not buffered by means of buffering because reference teaches playing out the buffered program till it catches up with the real program *as the user may do this by fast forwarding* buffered program till it catches up

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with the real program (fig. 26 col. 46 lines 14 through 17)" (emphasis added)

However, it is submitted that the ability of the user to fast forward through portions of the program during playback of the program (which is what is being discussed in col. 46) does not disclose to one of ordinary skill in the art that "a portion of the real time program is not buffered by the means for buffering". To the contrary, the discussion in the Asmussen patent of the capability of the user to fast forward through the buffered program suggests that all of the program is buffered, but then the user may fast forward through sections of the buffered program at playback. This operation of Asmussen is different than not buffering of a portion of the program in the first place. In other words, the Asmussen patent discusses skipping portions of the program that have already been buffered, which clearly discloses that the sections of the program that are fast forwarded through have already been buffered and then skipped (as one would not have to fast forward a section of the program that was not buffered in the first place). The need for a user of the Asmussen system to fast forward through sections of the buffered programs to bring the "buffer point" toward the "point of current transmission" tells one of ordinary skill in the art that the Asmussen system does not provide that "a portion of the real time program is not buffered by the means for buffering".

As previously noted, in the rejection of claim 12, it is alleged that: wherein the portion of the real time program is not buffered by the means for buffering to facilitate coincidence of the buffered program with the real time program (this is implied in as much as the reference teaches buffered program is played out till it catches with real time program (figs 25-26, col. 45 lines 41-51).

Looking to the portion of the Asmussen patent that is being referenced, it is stated at col. 45, lines 41 through 51 that:

Upon reading the video signal from buffer 1420, various processing of it may occur for subsequent display on a television or

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other display device. For example, the stored video signal is typically converted to an analog signal, amplified, and filtered before transmission to the display device. A transmission point 1425 illustrates a point of transmission of the video program from buffer 1420 to display 1424. Therefore, when the system transmits the video program from the start of the buffer, with transmission point 1425 corresponding to the point of current transmission 1422, the video program is transmitted in real-time.

The fact that the Asmussen patent does not discuss that "a portion of the real time program is not buffered by the means for buffering", as is required by claim 12, is apparently conceded in the rejection, since the rejection states that this requirement of claim 12 is "implied" in the Asmussen patent. It is submitted that the rejection is therefore based upon the position that the Asmussen patent inherently operates such that "a portion of the real time program is not buffered by the means for buffering". It is submitted that reliance upon an "inherent" disclosure of a feature requires that the feature is necessarily present.

The law on establishing that a feature is inherently ("implicitly") present in a document is clear—the Patent Office must "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art". The burden upon the office is more fully set forth in the MPEP at section 2112, where it states (all emphasis in original, case summaries omitted):

2112 Requirements of Rejection Based on Inherency; Burden of Proof [R-3] - 2100 Patentability

IV. EXAMINER MUST PROVIDE RATION-ALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference,

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and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

However, it is submitted that the Asmussen system does not necessarily employ this technique (or any other technique as discussed below), nor does it communicate to one of ordinary skill in the art that necessarily a portion of the program is not buffered. The burden is upon the Patent Office to establish that this claimed feature necessarily occurs in the Asmussen system, and that the claimed feature cannot be performed by some other means or technique than that which is claimed.

Moreover, it is also submitted that the Asmussen patent does not disclose that the Asmussen system includes any means for actively causing the "transmission point" to move to the "point of current transmission". Asmussen merely states that when these two "points" coincide, that the "program is transmitted in real-time". Clearly, the vague reference to "processing of [the video signal]" in the portion of Asmussen relied upon could mean many things, and without any clear statement that the Asmussen system actively attempts to cause a correspondence between the points, one of ordinary skill in the art is left to guess what the "processing" might entail.

Still further, the Asmussen patent suggests that its system avoids the situation where "the user typically would otherwise lose portions of the transmission when the video program is paused" (see col. 45, lines 8 et seq.). It is therefore submitted that one of ordinary skill in the art,

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considering the discussion in the Asmussen patent, would not be led to the requirements of claim 12.

Claim 20

Further, claim 20 requires in part "playing back the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program" and "wherein the instructions cause the computer to perform the play back of the buffered program in a manner faster than an original reception of the real time program". Support for these amendments can be found throughout the disclosure, and particularly at page 6, lines 3 through 24.

It is alleged in the "Response to Arguments" that:

Regarding [applicant's remarks with respect to the rejection of claim 20], contrary to applicants interpretation of Asmussen patent, Asmussen patent does teach: buffering the program the user is watching in response to communication events such as in response to phone call or in response to off-hook detection (col. 44 lines 57-67) and playing back subsequently after the communication event to catch up to the real program after playing the buffered program faster (col. 45 lines 41-52; col. 46 lines 14-17). This clearly teaches applicant claim limitations such as: wherein displaying the buffered program is performed in a manner faster than the reception of the real time program. After all, applicant is doing something similar to Asmussen patent. Applicant's specification discloses the following: once the call is ended, the buffered video is played back on the display from the point at which it was interrupted. Standard video controls, such as fast forward and rewind, are provided via user input device. Such input device 109 may comprises a remote control in one embodiment Using these video controls, portions of the video may be skipped or fast forward if desired (page 3, left hand column, lines 4-10 of published application of applicant's: US 2004/0177378A1).

However, the referenced portion of the Asmussen patent refers to *the user* pressing the fast forward button ("The user may fast forward the video program, in which case buffer point 1425 moves in fast forward direction 1426 toward the point of current transmission 1422 as the buffered video program is transmitted to display 1424" Asmussen at col. 46, lines 14

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through 17) but does not disclose or suggest the requirement of claim 20 as amended.

Also, merely because the disclosure of the present patent application also discusses fast forward and fast reverse functions that are initiated by the user does not equate the user-initiated fast forward operation of Asmussen with the faster playback of portions of the buffered video disclosed in the specification and recited in claim 20.

Claim 21

Claim 21 requires, in part, "a buffer coupled to the controller, wherein the buffer is configured to initiate buffering of the real-time program from the display of caller identification information for the call the buffer being further configured to not buffer portions of the real-time program such that when the buffer provides the buffered program to the display upon the termination of the call for playback of the buffered program, the portions of the real-time program not buffered are not played back and the buffering continues until the buffered program coincides with the real-time program".

It is stated in the "Response to Arguments" that:

Regarding rejection of claim 21 using Asmussen patent Applicant makes similar arguments as made for claim 20 and response provided therein is applicable here also.

However, it is submitted that the requirements of claim 21, especially as amended above, are not disclosed or suggested by Asmussen. Clearly, Asmussen only discusses the option to fast forward through the play back of the recorded program, and not to *not* buffer portions of the application.

Claim 22

Claim 22 requires in part "wherein said means for recording records the video input signal prior to a detection of an incoming phone call by said means for detecting such that the recorded video input includes a portion of the video input signal recorded prior to the detection of an incoming phone

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call so that displaying the buffered program includes the portion of the video input signal the video input signal recorded prior to the detection of the incoming phone call".

It is further stated in the "Response to Arguments" that:

Regarding this limitation [of claim 22], Applicant's sole disclosure in applicant's claim limitation such: where in means for recording records the video input signal prior to detecting an incoming phone call by the means for detecting such that the recorded video input includes a portion of the video input signal prior to detecting an incoming phone call so that displaying the buffered program includes the portion of the video input signal prior to the detecting of the incoming call" is in paragraph:0023 which discloses: in a further embodiment, several seconds or other predetermined time of the video or audio signals are always buffered such that the replay of the buffered signals following a call occurs from a point several seconds prior to first indication of the call. Applicant seems to be using this limited and sparse disclosure for claim limitation of claim 22 such as where in means for recording records the video input signal prior to detecting an incoming phone call by the means for detecting such that the recorded video input includes a portion of the video input signal prior to detecting an incoming phone call so that displaying the buffered program includes the portion of the video input signal prior to the detecting of the incoming call. In light of this, Asmussen patent also discloses this: although transmitted in real time, the apparatus simultaneously buffers incoming video signal for subsequent use in performing various video program control features (col. 45 lines 52-54), where video program control features include play back at normal speed or fast word at greater speed (col. 46 lines 14-17). This clearly reads on applicant's above claim limitation as Asmussen clearly teaches buffering the program simultaneously with transmission in real time which what applicant's system does.

However, the Asmussen patent at col. 45, lines 52 through 54 is discussing the simultaneous buffering of the video signal while buffered video is being transmitted to the display for playback. It states:

Although transmitted in real-time, the apparatus simultaneously buffers the incoming video signal for subsequent use in performing various video program control features.

This does not disclose to one of ordinary skill in the art that a real-time program is being recorded *prior to* detecting an incoming phone call.

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Asmussen here is merely discussing what is happening *after* the Asmussen system has begun buffering the video signal, *after* the system has detected an incoming call. The buffered video signal can be used for various purpose, but this does not disclose to one of ordinary skill in the art that any of the buffered video signal preceded the receipt of a phone call. Asmussen states at col. 43, lines 35 through 38 states:

An apparatus and method consistent with the present invention provides for automatically pausing of a video program in response to detection of an occurrence of a communications event or related triggering event.

This portion of Asmussen states that the pausing, and buffering, of the program is triggered by a "communications event". There is nothing in the Asmussen patent that discloses to one of ordinary skill in the art that any portion of the video signal is recorded *prior to* the trigger of a "communications event".

Further, it is submitted that the allegedly "sparse" character of the disclosure of the feature in the present application does not affect the requirements for anticipation—namely that the Asmussen patent must disclose to one of ordinary skill in the art the claimed feature in order to anticipate it, and therefore it is submitted that the Asmussen patent does not disclose the combination of requirements of claim 22.

Withdrawal of the §102(e) and 103(a) rejection of claims 1 through 3, 6 through 13 and 16 through 31 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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By



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